

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/10 has been entered.

Terminal Disclaimer

2. The terminal disclaimer filed on 2/19/10 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/955,557 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 23 February 2010), can be read <http://www.uspto.gov/web/offices/com/sol/of/2010/week08/TOC.htm#ref20>

Claims 26-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 26-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 26-50 are drawn to functional descriptive material recorded on a computer readable medium. Normally, the claim would be statutory. However, through the guidelines of February 23, 2010 Official Gazette Notice,

The United States Patent and Trademark Office (USPTO) is obliged to give Claims their broadest reasonable interpretation consistent with the Specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent.

Specification, at page 36 lines 1-5 define the claimed computer readable medium as encompassing media such as magnetic cassette, flash memory cards, digital video disks, RAM, ROM and the like. The broadest reasonable interpretation, the examiner interprets and the like to include a signal which is ***non-statutory*** subject matter.

“A transitory, propagating signal … is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” (*In re Nujten*, 84 USPQ2d 1495 (Fed. Cir. 2007)).

Because the full scope of the claim as properly read in light of the disclosure appears to encompass non-statutory subject matter (i.e., because the specification defines/exemplifies a computer readable medium as a non-statutory signal, carrier waver, etc.) the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable storage media, while at the same time excluding the intangible transitory media such as signals, carrier waves, For example claims to include non-transitory tangible computer readable medium. Any amendment to the claim should be commensurate with its corresponding disclosure.

Allowable Subject Matter

4. Claims 1-25 and 51 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (571) 272-7449. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

G.D.

March 25, 2010

/Gregory M. Desire/
Primary Examiner, Art Unit 2624